

Serial Number 10/033,868
14X/00134 / GFM-0084

REMARKS / ARGUMENTS

Status of Claims

Claims 1-20 are pending and stand rejected. Of the pending claims, Applicant has amended Claims 1, 8 and 16, leaving Claims 1-20 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(b) and 35 U.S. C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Rejections Under 35 U.S.C. §102(b)

Claims 1, 2, 5, 6, 8-13 and 16-20 are rejected under 35 U.S.C. §102(b) as being anticipated by Siczek (U.S. Patent No. 5,386,447, hereinafter Siczek).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that a claim is anticipated under 35 U.S.C. §102(b) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, and not merely taught by the reference where an interpretation, absent specific disclosure, is necessarily required for the rejection to stand.

The Examiner alleges that Siczek teaches the examination arm (52, 54) being further mounted for rotation ("G") about a second horizontal axis substantially perpendicular to the first axis (56) and to the examination arm (52, 54) (Figs. 1 & 2). Paper 20040513, page 3.

In respectful disagreement with the Examiner, Applicant finds Siczek, at Figures 1 and 2, and at column 7, lines 40-46, to disclose a beam source 19 slidably carried by arcuate arm 58 mounted on arm 52 to be movable along arcuate arm 58 as shown by arrow "G". Contrary to the Examiner's finding, Applicant finds beam source 19 and not examination arm (52, 54) to be mounted for rotation ("G") about the second axis defined by the center of curvature of arcuate arm 58 and substantially perpendicular to first axis (56) and to examination arm (52, 54).

Serial Number 10/033,868
14X/00134 / GFM-0084

Even if Applicant were to consider pivot pin 42 to be the second axis substantially perpendicular to the first axis (56) and to the examination arm (52, 54), as disclosed at Figures 1 and 2, and at column 6, lines 10-14, the claim element of second axis (pivot pin 42) being substantially perpendicular to examination arm (52, 54) is lost once examination arm (52, 54) is rotated about first axis (56). Accordingly, Siczek discloses a substantially different invention to the claimed invention.

For this reason alone, Applicant respectfully submits that Claims 1, 8 and 16, are patentably distinguishable over Siczek under 35 U.S.C. §102(b). Dependent claims inherit all of the limitations of the parent claim.

Furthermore, Applicant respectfully submits that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*" *Verdegal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the *** claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant has amended Claims 1, 8 and 16, to more clearly describe the subject matter considered to be the invention.

Claims 1 and 8 now recite, inter alia, "...the arm being further mounted for rotation about a second axis substantially perpendicular to the first axis and to the examination arm, the second axis being disposed between the one end and the other end of the examination arm", and Claim 16 now recites, inter alia, "...wherein the second axis is substantially perpendicular to the first axis and to the examination arm, the second axis being disposed between the one end and the other end of the examination arm." Support for the claim amendments may be found in the specification as originally filed at paragraphs [0012] and [0014] and at Figure 1. No new matter has been added. Dependent claims inherit all of the limitations of the respective parent claim.

Here, Applicant claims a second axis 22 disposed between the one end (having image receiver 16) and the other end (having radiation delivery head 14) of examination arm 12 such that second axis 22 is substantially perpendicular to the first axis 20 and to

Serial Number 10/033,868
14X/00134 / GJM-0084

the examination arm 12 regardless of the position of examination arm 12 about first axis 20, which is not disclosed in Siczek and is a substantially different invention to that of Siczek.

At paragraphs [00011] and [0014], and Figure 1, Applicant discloses that the position of support 4 on support column 2, via translatable movement 6, and the angular position of examination arm 12, rotating about axis 22, may be set, thereby setting the plane in which examination arm 12 will move during rotation about axis 20.

At Figures 1 and 3, Applicant discloses different orientations of axis 20 rotated about axis 22 that will accommodate a patient who may remain standing on the ground.

Contrary to the instant invention, Siczek discloses a frame assembly 12 that includes a platform 28 on which the patient stands, which results in the patient herself being rotated about axis (pivot pin) 42 as axis 56 is rotated about axis 42, as seen by comparing Figures 1 and 3 of Siczek.

Accordingly, not only does Siczek not disclose each and every element of the claimed invention, but Siczek also does not teach, suggest or motivate one skilled in the art to arrive at the claimed invention.

In view of the foregoing amendment and remarks, Applicant respectfully submits that Siczek does not disclose each and every element of the claimed invention and discloses a substantially different invention than the claimed invention, and therefore cannot be anticipatory. Accordingly, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §102(b) has been traversed, and requests that the Examiner reconsider and withdraw this rejection.

Regarding Claims 5 and 6 Specifically

The Examiner alleges anticipation through a broad sweeping rejection absent specific reference to anticipatory elements that may be found in the cited reference, and alleges that Siczek anticipates the claimed invention by *suggesting* and *teaching* the claimed subject matter. Paper 20040513, pages 3-4.

In view of the absence of specific anticipatory elements being identified in Siczek, Applicant respectfully submits that the Examiner has failed to properly meet the burden

Serial Number 10/033,868
14X200131 / GIM-0084

of a showing of anticipation, and respectfully requests that the Examiner reconsider and withdraw these rejections.

Rejections Under 35 U.S.C. §103(a)

Claims 3, 4, 7, 14 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Siczek.

Applicant traverses the Examiner's rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Applicant has amended the respective parent Claims 1 and 8 from which Claims 3, 4, 7, 14 and 15, respectively depend, and has remarked above on the significance of those amendments in reference to the rejections under 35 U.S.C. §102(b).

In view of the amendments to Claims 1 and 8, in combination with the aforementioned remarks, Applicant submits that Siczek fails to teach or suggest each and every element of the claimed invention and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.


Serial Number 10/033,868
14X/00134 / GFM-0084

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 07-0845.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,

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